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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,143	12/18/2000	Koichi Hata	MAT-8070US	9841

7590

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/739,143		<b>Applicant(s)</b> HATA ET AL.	
	<b>Examiner</b> Gregory J. Vaughn		<b>Art Unit</b> 2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 18 December 2000.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-24 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 18 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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## **DETAILED ACTION**

### ***Application History***

1. This action is responsive to the application filing, Application filed on 12/18/2000.
2. Applicant submits Claim to Right of Priority with a certified copy of Japanese patent Application No. 11-359248 on 4/27/2001.
3. Claims 1-24 are pending in the case, claims 1, 5, 7, 8, 9, 13, 15, 16, 17, 21, 23, and 24 are independent claims.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy was received on 4/27/2001 and placed in the application record.

### ***Information Disclosure Statement***

5. The listing of references in the specification (see page 2, lines 5-10 and page 9, lines 12-13) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "*the list may not be incorporated into the specification but must be submitted in a separate paper.*" Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "2600" on page 7, line 24.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "1212" in Figure 12.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

8. The disclosure is objected to because of the following informalities:

- The disclosure recites those reference signs listed in paragraph 6 above, which are not shown in the drawings.

- The disclosure fails to disclose those reference signs listed in paragraph 7 above, which are shown in the drawings.

Appropriate correction is required.

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 101***

10. The following is a quotation of 35 U.S.C. 101:

*"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*

11. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
12. The claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. The claims 1-16 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

14. Claims 1-4, 9-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. US Patent 6,345,279, filed 4/23/1999, patented 2/5/2002, (hereinafter "Li").

15. **Regarding independent claim 1**, Li recites: *"The present invention adapts multimedia content, e.g., Web documents, to optimally match the capabilities of the client device requesting it. Each Web document is a set of items, each of which is authored in a particular modality such as text or image"* (column 2, lines 20-24) and *"The "resources" of a client can be divided up among several items on a Web page"*

(column 6, lines 19-20). Li discloses in Figure 3 at reference sign 100 the division of document-image data (shown as "*Content Items Aj*") at reference signs 120. The individual document-image data items are processed (shown as "*Transcode*") at reference sign 250. Li discloses a renewed structure image data (shown as "*Customized Document*") at reference sign 370.

Li discloses a structured image data processing method where the structured image data items are divided, processed and renewed as described above. Li fails to explicitly describe the positioning data of the structured image data items. However, Li discloses in Figure 3, the maintained position of structured image data items through the method processing, as shown by the position of the image data items (shown as "*Content Items*") in steps shown at reference sign 100 (original content division step) to reference sign 340 (processing step) to reference sign 370 (renewed content step).

Therefore, it would have been obvious, to one of ordinary skill at the time the invention was made to use Li's content adaptation of multimedia information with positioning control in order to provide "*an adaptation process that selects the best representation to meet the client capabilities while delivering the most value to the client*" (Li, column 2, lines 50-52).

16. **Regarding dependent claim 2**, Li recites: "*Some exemplary transcoding processes 250 are listed below by modality of the version and the conversions performed to generate versions at different resolutions and modalities: (i) images: resolution--spatial size reduction, color depth reduction*" (column 5, lines 27-32) and

Li further discloses equations in columns 7 and 8 where the difference between the original and various versions of the image data item are determined.

17. **Regarding dependent claim 3**, Li recites: "Further, the invention permits content to be authored in XML (Extensible Markup Language, as is known in the art), allowing the author to provide more information to the transcoding and adaptation systems than can be deduced from an HTML (hyper text markup language) page. One benefit of the server-based system of the invention is that due to the guidance provided by the author, a significantly greater level of customization can be performed than is possible in previous transcoding proxies" (column 2 line 63 to column 3, line 4) and "For example, in image search engines, the match scores of the returned images serve as priorities. Priorities can be assigned based on match scores for various dynamically generated pages" (column 7, lines 11-14)
18. **Regarding dependent claim 4**, Li recites: "*The InfoPyramid may include procedures and rules for translating and summarizing (transcoding) between modalities and resolutions. The InfoPyramid may also contain meta-data for each constituent version such as, for example, size, color, bandwidth requirements, publisher preferences, etc*" Column 5, lines 1-5) and "*The present invention adapts multimedia content, e.g., Web documents, to optimally match the capabilities of the client device requesting it. Each Web document is a set of items, each of which is authored in a particular modality such as text or image*" (column 2, lines 20-24).



19. **Regarding independent claims 9 and 17**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 1, and are rejected using the same rationale.
20. **Regarding dependent claims 10 and 18**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 2, and are rejected using the same rationale.
21. **Regarding dependent claims 11 and 19**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 3, and are rejected using the same rationale.
22. **Regarding dependent claims 12 and 20**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 4, and are rejected using the same rationale.
23. Claims 5-8, 13-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Fields et al. US Patent 6,606,120, filed 12/10/1998, patented 8/1282003, (hereinafter "Fields").
24. **Regarding independent claim 5**, Li discloses a structured image data processing method where the structured image data items are divided, processed and renewed as described above. Li also teaches positioning as described above. Li fails to disclose the use of replaced media dividing information. Fields teaches the use of replaced media dividing information. Fields discloses in Figure 5A at

reference sign 421, the replaced media dividing information (shown as "*Apply Filter Definition*").

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the multimedia content adaptation of Li with the dividing information as taught by Fields, in order "*to develop a filter for extracting desired content elements from a set of web pages*" (Fields, column 2, lines 45-46).

25. **Regarding dependent claim 6**, Li discloses a structured image data processing method where the structured image data items are divided, processed and renewed as described above. Li also teaches positioning as described above. Li and Fields disclose the use of replaced media dividing information. Li fails to disclose the media dividing information as text. Fields discloses the use of text as the media dividing information. Fields disclose in Figure 5B at reference sign 459 the use of text to divide (shown as "*Parse Page According To Embedded Tags And/Or Defaults*").

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the multimedia content adaptation of Li with the dividing information as taught by Fields, in order to provide the benefit of "*automatically update material on the hosting web site as it is changes on the content provider web sites*" (Fields, column 2, lines 54-56).

26. **Regarding independent claims 7 and 8**, Li discloses a structured image data processing method where the structured image data items are divided, processed

and renewed as described above. Li also teaches positioning as described above. Li discloses the use of scores as described above. Li fails to disclose the use of a first and second input. Fields discloses the use of multiple inputs. Fields discloses multiple inputs in Figure 8 at reference sign 801 (shown as "*Multiple Copies of Target URL*").

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the multimedia content adaptation of Li with the dividing information as taught by Fields, in order to provide the benefit of "*automatically update material on the hosting web site as it changes on the content provider web sites*" (Fields, column 2, lines 54-56).

27. **Regarding independent claims 13 and 21**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 5, and are rejected using the same rationale.
28. **Regarding dependent claims 14 and 22**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 6, and are rejected using the same rationale.
29. **Regarding dependent claims 15 and 23**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 7, and are rejected using the same rationale.

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30. **Regarding dependent claims 16 and 24**, the claims are directed toward an apparatus and a computer program (respectively) for the method of claim 8, and are rejected using the same rationale.

### ***Conclusion***

31. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

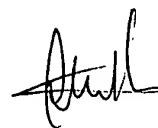
<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,923,738	07-1999	Cardillo et al.
• US-6,128,655	10-2000	Fields et al.
• US-6,226,642	05-2001	Beranek et al.
• US-6,237,031	05-2001	Knauerhase et al.
• US-6,247,048	06-2001	Greer et al.
• US-6,345,300	02-2002	Bakshi et al.
• US-6,345,303	02-2002	Knauerhase et al.
• US-6,347,323	02-2002	Garber et al.
• US-6,421,733	07-2002	Tso et al.
• US-6,457,030	09-2002	Adams et al.
• US-6,483,851	11-2002	Neogi, Raja
• US-6,535,896	03-2003	Britton et al.
• US-6,564,263	05-2003	Bergman et al.
• US-6,615,212	09-2003	Dutta et al.
• US-6,643,825	11-2003	Li et al.
• US-6,684,257	01-2004	Camut et al.
• US-6,715,129	03-2004	Hind et al.
• US-6,741,608	05-2004	Bouis et al.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
June 28, 2004



STEPHEN S. HONG  
PRIMARY EXAMINER